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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/776,420	SCHULTZ ET AL.	
	Examiner	Art Unit	
	Daniel S. Felten	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 17-23 and 27-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 17-23 and 27-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/10/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Receipt of the amendment filed July 07, 2006 amending claims 1, 17-23, 27 and 32, canceling claims 6-16, 24-26 and adding claims 43-49 is acknowledged. Claims 1-5, 17-23 and 27-49 are pending in the application and are presented to be examined upon their merits.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on August 10, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

3. Applicant's arguments filed July 07, 2006 have been fully considered but they are not fully persuasive.

Regarding the 35 USC 101 rejection:

The 35 USC 101 rejection from the January 06, 2006 Office Action is maintained. It is respectfully submitted that descriptive material can be categorized as either 'functional descriptive material: or "nonfunctional descriptive material." Functional material consists of data structures and computer programs which impart functionality *when employed as a computer component*. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulations functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th Ed. 1993)). As applicant has pointed out nonfunctional descriptive material includes, *but is not limited to*, music literary works and a mere compilation or mere arrangement of data. Both types of "descriptive material " are

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nonstatutory when claimed as descriptive material (see per se Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759). It is maintained that the detailed information included in the electronic receipt is nonfunctional descriptive material because the information itself does not change how the process/method is performed. Thus the claimed sales price, sale tax, total transaction amount does not change how the computer performs the method (e.g., making the computer more efficient) (see In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1-31, 1035 (Fed. Cir. 1994). In any case both descriptive material are nonstatutory when claimed as descriptive material per se. Thus the 35 USC 101 rejections are maintained.

In regards to the USC 103(a) Rejection:

New prior art is presented to be considered by the applicant in view of the amendments and newly presented claims.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on August 10, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method of

“...storing in a centralized database...” in claim 1

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“...generating aggregate information,...providing the aggregate information in response to the stored receipts...,” in claim 2,

“...one of the buyers remotely searching the centralized database...etc.,”

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Moreover, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit claim to a particular structure. Claim language (as in claim 1, 17, 27, 32 for example), “wherein” or

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wherein clauses, may raise a question as to the limiting effect to the language (see MPEP 2111.04)

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2-5, 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

--from the specification it talks about accessing aggregate information but I don't understand how aggregate information is being generated. What does this step have to do with collecting electronic receipts for purchases

--There is no mention in the specification about "a link to *supplemental* information"

--the word "object" has both software and graphical connotations. It can also mean a variable comprising both routines and data. What are explicitly are you considering a electronic receipt object?

--in claim 39, what do you mean by "rendering?"

Claim Rejections - 35 USC § 101

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8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 18 and 20-23, 42 as similarly discussed in the Response to Arguments, merely present nonfunctional descriptive language which provide abstract ideas that describe a type of information without providing a concrete, tangible result.

Moreover, the claims are replete with “wherein clauses” which raise a question as to the limiting effect to the language (see MPEP 2111.04)

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2-5, 17 and 27-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al (US 5,915,022)

Robinson discloses a method for collecting electronic receipts for purchases (see Robinson, Abstract, column 1, lines 7-11), *as in claims 1, 27 and 32*

-conducting a sales transaction between a buyer and a seller (see Robinson, column 2, lines 32-57; and column 3, lines 31-34), *as in claims 1, 27 and 32*

--generating from the sales transactions and electronic sales receipt including detailed information describing the items purchased the detailed information includes sale price, sale tax,

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total transaction amount, and information indicating completion of the transaction (see column 2, lines 50-57; fig. 6a column 5, line 53 to column 6, line 5), *as in claims 1, 17, 27, 42*

--transmitting the sales receipt via a computer network to a computing device operated by or on behalf of the buyer, the buyer being presented view a user interface of the device with a representation of the detailed information describing the items purchased (see column 5, lines 53 to column 6, line 5), *as in claims 1, 27 and 32*

--performing steps a-c for a plurality of transactions such that at least one buyer conducts a sales transaction with each of a plurality of buyers (see column 3, lines 45+), *as in claims 1, 27 and 32*

--storing in a centralized database a record of each of each sales receipt generated for each transaction of a plurality of transactions, *wherein* the centralized database belongs to a third party (see column 4, lines 66 to column 5, line 1), *as in claims 1, 17, 27 and 32*

--capturing detailed information regarding each of a plurality of sales transactions (see column 2, lines 50-57; fig. 6a column 5, line 53 to column 6, line 5), *as in claim 32*

--selecting a record in the centralized database associated with a selected buyer;

--organizing the record based on a buyer preference on (see column 2, lines 50-57; fig. 6a column 5, line 53 to column 6, line 5); and

--sending the supplemental information to a user interface for displaying the supplemental information associated with the at least one item purchased as stored in the selected record (see column 5, lines 53 to column 6, line 5)

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--as in claims 2 and 28, Robinson discloses generating aggregate information in response to stored receipt providing the aggregate information to one of the sellers (see Abstract, "*present the digital receipt to the merchant or institution*" and "transaction history", column 8, lines 45+)

--as in claims 3-5, information is searched (compared) from the centralized database, retrieved and transmitted (see column 8, lines 45 to column 9 line 12)

--as in claim 29, remotely searching the database in response to search criteria

--as in claim 30, the sales receipt object provides a store function for adding information to the sales receipt object, the method further comprising the step of adding information to the found sales receipt object using the store function

--as in claim 31, the step of one of the buyers downloading information in the found sales receipt objects to financial software as indications of purchases

--as in claim 33, wherein the selected data format is a text file or a binary file (see Robinson, column 2, lines 51-57)

--as in claims 34 and 35: Robinson Internet languages HTML and or XML (see column 6, lines 23-47).

--as in claim 36, the selected data format is a MICROSOFT EXCEL file, MICROSOFT WORD file, MICROSOFT MONEY file, or QUICKEN file (see column 2, lines 50-57).

--as in claims 37, wherein the sales receipt object is a JAVA class, JAVA applet, JAVA application, ActiveX object, or a SOAP object (see column 7, lines 57 to column 8, line 4).

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--as in claim 38: the sales receipt object provides an encryption function capable of encrypting selected detailed information stored in the sales receipt object (see column 8, lines 6-11)

-- as in claim 39, the sales receipt object provides a function for retrieving selected detailed information from the object, further comprising the steps of:

(a) executing the function to retrieve selected detailed information from the sales receipt object (see column 8, lines 45-57); and

b) rendering the selected retrieved detailed information in a user interface of the computing device . (see column 8, lines 45-57)

--as in claim 40, the user interface is a web browser (see column 7, lines 57-63).

--as in claim 41, the computing device is a finance management system (see Robinson, Abstract).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 18-23 and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al (US 5,915,022) in view of ReceiptCity, POS.COM (copyright 1999)

Regarding claims: 18-23 and 43- 49: Robinson discloses a customer and a merchant but fails to disclose a third party. ReceiptCity represents a third party which processes and owns the

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database and conducts electronic receipt transactions over the Internet (see FAQs for ReceiptCity). It would have been obvious for Robinson to integrate a third party (ReceiptCity website) into the invention to help resolve disputes between the merchant and the customer from electronic transactions over the Internet by providing a secure, trusted and neutral party website. Thus such a modification would allow faster/easier dispute resolution between parties and thus be an obvious expedient to the applicant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-66712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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